

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/517,588

Applicant(s)

FUCHS ET AL.

Examiner

Nathan M. Nutter

Art Unit

1796

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 26 June 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 17-30.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

Continuation of 3. NOTE: The recitation of "comprising a tensile E modulus ranging from 150 MPa to 800 MPa" has not been provided with support from the Specification, as originally filed. The amendment would require the further consideration of the inserted matter and new search thereto. Since the amendment is not being entered, all other rejections are maintained, and for the reasons presented. The rejection of claim 18, only, under 35 USC 103(a) as being unpatentable over Datta et al (US 6,635,715), is hereby expressly withdrawn. The rejection as to claims 17 and 19-27 is being maintained, and for the reasons set out..

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection of claims 17-30 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 and 9-15 of copending Application No. 10/517,580 (Fuchs et al US 2006/0167185), is hereby expressly withdrawn in view of the acceptable terminal Disclaimer filed 26 June 2009.

Continuation of 13. Other: While applicants' arguments are directed to the claims, as amended, as not-entered herein, the rejections are being maintained for the reasons set out. It is pointed out that nothing as to Charpy impact toughness values and Charpy notched impact toughness values is recited in the claims. A reference is viewed for the entirety of its teachings. Further, there is no direct comparison seen as to the values as outlined at page 7 of applicants' response of 26 June 2009. Applicants' Example is based upon the copolymer, ALONE. The Fischer et al values are determined from the FINAL COMPOSITION. Note column 15 (lines 41-45) of the patent. In this regard it is pointed out that the claims are the subject of the patent, not the disclosure. As regards the reference to JMehta et al, the reference is cited only for the teaching of the nucleant, not as the basis of a separate rejection under 35 USC 102 or 103, as apparently assumed by applicants. The disclosure of Fischer et al is deemed sufficient to obviate the instant claims otherwise. As regards the rejection of the claims over the reference to Datta et al, the instant claims and the reference are drawn to a composition. Applicants have failed to show by direct comparison or other reasoning that the reference composition differs from that recited and claimed herein. Once a reference teaching a product appearing to be substantially identical is made the basis of a rejection and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). In re Schreiber, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997)..